

### III. REMARKS/ARGUMENTS

#### A. Status of the Claims

Claims 11-35 are pending. Claims 1-10 have been cancelled, without prejudice. Claims 12, 13, 17, 18, 20-26, 32 and 34 are withdrawn from consideration. Claims 15, 16, 30 and 35 are allowed. Claims 11, 14, 19, 27-29, 31, 33 and 35 stand rejected. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

#### B. Claim Rejections Under 35 U.S.C. § 102(b)

Claims 11, 14, 19, 27-29, 31 and 33 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,846,958 to Divan. Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the . . . claim.”).

Independent claim 11 recites:

An apparatus for applying thin sections of a tissue sample to a receiving medium comprising:

a blade assembly for slicing a histologic-grade slice from a tissue sample;

a plurality of transfer rollers sequentially arranged in tangential proximity to each other, such that said **histologic-grade slice** in contact with a surface of one transfer roller will be transferred to the surface of the sequentially successive transfer roller;

wherein a first sequential transfer roller of said plurality of transfer rollers is oriented in proximity to said blade assembly so that said **histologic-grade slice** sliced from said tissue sample will contact the surface of said first sequential transfer roller; and

a receiving medium disposed in tangential proximity to a final sequential transfer roller of said plurality of transfer rollers so that said **histologic-grade slice** on the surface of said final sequential transfer roller will be transferred to said receiving medium in a substantially smooth and flat configuration;

**wherein the histologic-grade slice has a thickness of between 1 and 10 microns.**

Appl'n, Claim 11 (emphasis added). Support for this amendment may be found at least in paragraph 0011 of the published application.

Applicants respectfully disagree with the assertion that "Divan is perfectly capable of cutting an item paper thin." There is no support in Divan for this assertion. As Applicants have argued previously, Divan does not disclose a device for slicing histologic-grade slices. Rather, Divan discloses an apparatus for slicing bacon and for the arrangement of the bacon in a shingled form with controlled weight. Divan, Col. 1, ll. 6-8. Bacon is not sliced in micron-widths; it is sliced to have a thickness that is several orders of magnitude thicker. Indeed, a slice of bacon on the order of 10 microns would be useless, as it would be impossible to manipulate in conventional manners, and would burn to a crisp, if not disintegrate, instantaneously upon cooking. Therefore, absent any disclosure, Divan cannot anticipate claims 11, 14, 19, 27-29, 31 and 33, and Applicants respectfully request allowance of independent claim 11 and all claims dependent thereon.

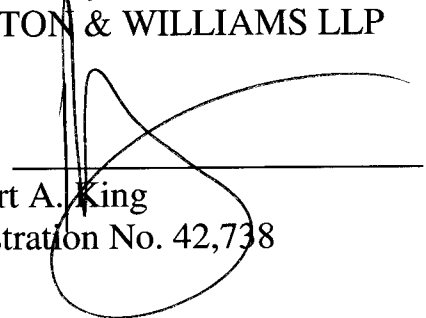
If the Office Action contends that Divan inherently discloses this feature, it must provide evidence of such. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP 2112 (citing In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993)) “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” Id. (quoting In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added)). Again, the Office Action has only asserted that “Divan is perfectly capable of cutting an item paper thin.” As the MPEP instructs, this is “not sufficient to establish the inherency of that result or characteristic.” Therefore, Applicants respectfully request that this rejection be withdrawn.

#### **IV. CONCLUSION**

Applicants respectfully submit that the application is in condition for allowance. Applicants believe that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,  
HUNTON & WILLIAMS LLP

Dated: August 11, 2008

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